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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,210	12/01/2003	Andreas Seidel	PO-7824/LeA 36,084	4685

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EXAMINER

BUTTNER, DAVID J

ART UNIT PAPER NUMBER

1712

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

CA

Office Action Summary	Application No.	Applicant(s)	
	10/725,210	SEIDEL ET AL.	
	Examiner	Art Unit	
	David Buttner	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/30/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-13 and 15-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-13,15-19 and 21-25 is/are rejected.
- 7) ☒ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claims 1,3-7,10-13,15-19 and 21-25 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Itagaki '766.

Itagaki exemplifies blends of polycarbonate, metablenS2001, phosphate flame retardant and PTFE. MetablenS2001 is one of applicant's preferred grafts (see page 22 line 27 of spec). Although the examples do not use branched polycarbonates, Itagaki (col 3 line 63) teaches the polycarbonate can be branched with isatinbiscresol. Use of such a branched polycarbonate would have been obvious if not considered anticipatory.

Claims 8-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Itagaki '766 in view of Idel '009.

Itagaki does not teach how much branching agent to use in the polycarbonate.

Idel exemplifies polycarbonates containing small amounts of isatinbiscresol (col 10 line 25). It would have been obvious to use these small amounts of branching agent in Itagaki's polycarbonate for the expected advantages. Also note Idel correlates MW to relative viscosity (col 7 line 41-45).

Claim 20 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Itagaki does not suggest these additional resins.

Applicant's arguments filed 3/30/06 have been fully considered but they are not persuasive.

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Applicant argues Itagaki does not require his graft to be other than butadiene based.

This is not convincing. Itagaki's graft is based on a acrylate/siloxane composite. This does not contain butadiene. Applicant's "other than polybutadiene" does nothing to distinguish from Itagaki.

Applicant argues Itagaki's polycarbonate is only optionally branched.

This is not convincing. Rejection over the broad disclosure (including alternatives) of the prior art is proper (MPEP 2123). A reference that clearly names the claimed species anticipates the claim no matter how many other species are named (MPEP 2131.02).

Applicant argues Itagaki does not recognize the unexpected ESC behavior when employing both the branched polycarbonate and non-butadiene graft together.

This is not convincing. Itagaki requires applicant's preferred graft. Whatever benefit this graft provides is inherent in the reference. To arrive at applicant's claims, one practicing Itagaki's invention would only have to choose whether or not to branch the polycarbonate and which branching agent to use. The examiner counts six branching agents in the reference. This means there are seven alternatives (including the non-branched alternative). A genus of seven species is small enough to enough to render all seven anticipated. (see *In re Schaumann* 197USPQ5). Also see the discussion in MPEP2131.02 under the heading "A Reference that Clearly Names the Claimed Species Anticipates the Claim No Matter How Many Other Species Are Named". Unexpected results cannot overcome an anticipatory rejection (MPEP

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2131.04). It is also noted that the claimed branching agent was not shown to be superior to any of the others listed by Itagaki.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Buttner

4/14/06

DAVID J. BUTTNER
PRIMARY EXAMINER

